

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10, 12, 13, 15-17, and 20-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant disclosure had not originally presented “polishing the panel after separation of said second layer of paper”, (**claim 10**). The instant disclosure had not originally presented “polishing after separation of said second layer of paper the panel”, (**claim 16**). The instant disclosure had not originally presented “the method consisting essentially of the steps of...”, (**claim 21**). The instant disclosure had not originally presented “polishing the panel after separation of said second layer of paper”, (**claim 21**).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 12, 13, 15-17, 20, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10, lines 16-17, “the surface of the panel previously covered by said second layer” lacks antecedent basis within the claim. It is therefore, not clear as to what “the surface of the panel previously covered by said second layer” refers.

Claim 16, lines 17-18, “a surface that was previously covered by said second layer” lacks appropriate antecedent basis within the claim. It is therefore, not clear as to what “the surface of the panel previously covered by said second layer” refers. Otherwise, it is not understood as to what is being defined by “a surface that was previously covered by said second layer” serves to define.

Claim 21, lines 18-19, “the surface of the panel that was previously covered by said second layer” lacks antecedent basis within the claim. It is therefore, not clear as to what “the surface of the panel that was previously covered by said second layer” refers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 13, 16, 17, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art process disclosed within the instant Background of the Invention in view of any of Baskin 4,956,030, Yukawa et al. 5,658,508, and

United Kingdom reference 1,127,296, (UK '296) and further in view of Edwardes et al. 2,172,466.

As for **claims 10, 16, 17, 20, and 21**, the instant Background of the Invention discloses as old and well known in the art the claimed invention, including vibration and vacuum pressing the panel, except for the process of separating the second layer of polyethylene-coated paper from the panel by lifting and removing the second layer of polyethylene-coated paper "substantially in a single piece" to produce cracks or "micro-cracks".

However, each of Baskin '030, Yukawa et al. '508, and United Kingdom reference '296 teach application and utilization of a polyethylene sheet material forming a covering during a molding operation forming a stone material with subsequent removal of the polyethylene sheet. Each of Baskin '030 and Yukawa et al. '508 teach application to a resin stone-like material with subsequent removal substantially in a single piece while UK '296 describes use of a polyethylene coated paper in substantially a single piece, col. 4, line 61 of Baskin '030, col. 6, lines 55-67 of Yukawa et al. '508, and page 2, lines 46-48 of UK '296.

Further, Edwards et al. teaches formation of a simulated stone slab as by forming minute cracks and fissures and recesses in the slab utilizing a layer 12/13 that is separated from the resulting stone panel in a single piece, col. 3, lines 29-52, (see also, col. 4, lines 30-37).

Therefore, to have formed the synthetic resin stone-like sheet described within the instant Background of the Invention as by applying the polyethylene coated paper

sheet and subsequently removing the sheet in substantially a single piece while forming cracks or “micro-cracks”, thus allowing for easy processing of the resulting artificial stone panel, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by any of Baskin ‘030, Yukawa et al. ‘508, and United Kingdom reference 1,127,296 and further in view of Edwardes.

As for the recitation “polishing the panel to obtain an impermeable surface layer on the antique-look surface of the panel, the instant Background of the Invention discloses as old and well known the process of polishing an artificial stone material.

As for **claim 13**, the instant Background of the Invention discloses as old and well known the process of utilizing a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene.

Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art process disclosed within the instant Background of the Invention in view of any of Baskin 4,956,030, Yukawa et al. 5,658,508, and United Kingdom reference 1,127,296, (UK ‘296) when considering Edwardes et al. 2,172,466, as applied to claims 10, 13, 16, 17, and 20 above, and further in view of any of Orsini 2,572,510, Rostoker 3,417,172, Sakai 6,127,458, and Hoesch 6,159,401 when considering either of Lemelson 3,553,905, and Ballhausen 2,798,474.

The process of forming a stone slab as realized by the instant Background of the Invention in view of any of Baskin ‘030, Yukawa et al. ‘508, and UK ‘296 when

considering Edwardes does not particularly include a step of polishing the resulting stone as by grinding with titanium grinding wheels.

However, each of Orsini '510, Rostoker '172, Sakai '458, and Hoesch '401 teach polishing of a synthetic stone-like slab as by grinding an outer surface thereof, (col. 4, line 45 of Orsini '510, col. 2, lines 11-13 of Rostoker '172, col. 8, lines 16-25 of Sakai '458, and col. 3, lines 15-17 of Hoesch '401), while either of Lemelson '905 and Ballhausen '474 teach as old and well known utilization of titanium grinding wheels for polishing natural or artificial stone elements, (col. 3, lines 10-13 and 24-28 of Lemelson '905 and col. 1, line 18-30 and col. 2, lines 2-10 of Ballhausen '474).

Therefore, to have subsequently polished the resulting synthetic stone panel of the modified process of the instant Background of the Invention, thus achieving an aesthetically accurate and pleasing appearance to the stone slab, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by any of Orsini '510, Rostoker '172, Sakai '458, and Hoesch '401 when further considering either of Lemelson '905, and Ballhausen '474.

As for **claim 15**, the instant Background of the Invention discloses as old and well known the process of utilizing a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art process disclosed within the instant Background of the Invention in view of any of Baskin 4,956,030, Yukawa et al. 5,658,508, and United Kingdom

reference 1,127,296, (UK '296) when considering Edwardes et al. 2,172,466, as applied to claims 10, 13, 16, 17, and 20 above, and further in view of any of Hare 4,980,224, Reed et al. 5,298,335, and Rottger et al. 5,865,953.

Though the instant Background of the Invention discloses as old and well known the process of utilizing a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene, each of Hare '224, Reed et al. '335, and Rottger et al. '953 teach application of polyethylene to a paper sheet as by spraying, (col. 3, lines 65-68 of Hare '224, col. 2, lines 16-20 of Reed et al. '335, and col. 1, line 67 to col. 2, line 6 of Rottger et al. '953).

Therefore, to have utilized a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene, thus realizing any and all advantages of such a coated sheet, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by any of Hare '224, Reed et al. '335, and Rottger et al. '953.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art process disclosed within the instant Background of the Invention in view of any of Baskin 4,956,030, Yukawa et al. 5,658,508, and United Kingdom reference 1,127,296, (UK '296) when considering Edwardes et al. 2,172,466, and any of Orsini 2,572,510, Rostoker 3,417,172, Sakai 6,127,458, and Hoesch 6,159,401 and either of Lemelson 3,553,905, and Ballhausen 2,798,474 as applied

to claims 12 and 15 above and further in view of any of Hare 4,980,224, Reed et al. 5,298,335, and Rottger et al. 5,865,953.

Though the instant Background of the Invention discloses as old and well known the process of utilizing a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene, each of Hare '224, Reed et al. '335, and Rottger et al. '953 teach application of polyethylene to a paper sheet as by spraying, (col. 3, lines 65-68 of Hare '224, col. 2, lines 16-20 of Reed et al. '335, and col. 1, line 67 to col. 2, line 6 of Rottger et al. '953).

Therefore, to have utilized a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene, thus realizing any and all advantages of such a coated sheet, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by any of Hare '224, Reed et al. '335, and Rottger et al. '953.

Response to Arguments

Applicant's arguments filed January 12, 2010 have been fully considered but they are not persuasive. Applicant's remarks at the bottom of page 6 of the response do not set forth specific support for the language "the method consisting essentially of the steps of..." as is recited within claim 21. The passages alluded to by Applicant do not set forth any "middle ground" between closed claims that are written in a "consisting of" format and fully open claims that are drafted in a "comprising" format. The original disclosure does not set forth or express that the disclosed invention "is open to unlisted

ingredients that do not materially affect the basic and novel properties of the invention.” For example, the original disclosure does not set forth or express any steps or elements “that do not materially affect the basic and novel properties of the invention” nor does the original disclosure offer any steps or elements “that would materially affect the basic and novel properties of the invention”.

Applicant’s arguments within the second full paragraph on page 7 of the response have been noted. However, it is not seen that either of the so called “vacuum pressing processes” and “pressure rolling processes” form any particular surface design apart from what may be desired by one practicing either of the processes. Further it is not seen why one having ordinary skill in the art would be precluded from realizing that a stone surface can and may be created as by applying the polyethylene coated paper sheet and subsequently removing the sheet in substantially a single piece while forming cracks or “micro-cracks”. The so called “vibration and vacuum pressing processes” serve to form any desired “cracks or “micro-cracks” while any of the “vacuum pressing processes”, “vibration and vacuum pressing processes”, and “pressure rolling processes” can and may teach applying the polyethylene coated paper sheet and subsequently removing the sheet in substantially a single piece thus allowing for easy processing of the resulting artificial stone panel.

As for Applicant’s argument found within the second full paragraph on page 8 of the response, the examiner can only disagree that the applied prior arts are from non analogous fields of endeavor. Contrary to Applicant’s assertion, the references to Baskin, Yukawa et al., UK ‘296 and Edwardes et al. are of the same field namely,

casting a plastic, (resin cementitious, etc.), material in the formation of a panel. The applied prior art does more than give general guidance. The prior art sets forth a specific procedural step that is employed in the manufacture of synthetic or plastic panels.

As for Applicant's arguments directed to "a surface having irregularities and cracks as claimed by applicant", language found at lines 2, 11-14 and 18-22 of claim 10 as well as at lines 2 and 20-21 of claim 16 and at lines 2, 11-12 and 17-20 of claim 21 is directed to a desired result. With the above modifications reproducing the claimed method steps any recited desired result would be effected minus a showing otherwise. See *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971):

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

The above rejections of claims 10, 16 and 21 present a method of forming a slab of agglomerate stone including use of a polyethylene-coated sheet which is eventually removed from the formed slab "in substantially a single piece". Therefore, the resulting panel would possess the same characteristics as that resulting from the instantly claimed method. The instant claims do not present any method steps above and beyond those method steps defined within the proposed rejections of the instant claims. As such, the instant claims would not serve to define any particular method step that might impart any such distinct characteristics to the resulting panel which might

differ from a resulting panel formed by the method steps defined within the proposed rejections.

Further reference is made to the examiners response to arguments within the Office action of December 01, 2009.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL SAFAVI whose telephone number is (571)272-7046. The examiner can normally be reached on Mon.-Fri., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darnell Jayne can be reached on (571) 272-7723. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Safavi/
Primary Examiner, Art Unit 3637

M. Safavi
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